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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,451	08/10/2001	Takao Uehara	S-2490	4601
7590 11/20/2003				
SHERMAN & SHALLOWAY 413 North Washington Street Alexandria, VA 22314				
EXAMINER SHOSHO, CALLIE E				
ART UNIT PAPER NUMBER				
1714				

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/925,451

Applicant(s)

UEHARA ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-4.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Attachment to Advisory Action

1. Applicants' arguments filed 11/5/03 have been fully considered but they are not persuasive.

Previously, applicants argued that none of the references cited by the examiner are applicable against the present claims because while each of the references discloses copolymer as presently claimed, none of the references teach a method for preventing a whitening phenomenon for solvent-borne paints as required in all the present claims. Applicants also argued that when claims are drawn to a new method of using either an old or obvious composition wherein the method has unobvious beneficial or useful effects, the new method claims are patentable even though the composition itself could not be patented.

In response, the examiner argued, based on MPEP 2112.02, that the discovery that the claimed copolymer has a new property, i.e. preventing a whitening phenomenon for solvent-borne paints, does not constitute a new use given that "when the claim recites using an old composition or structure and the "use" is directed to a result or properties of that composition or structure, then the claim is anticipated", *In re May* 574 F.2d 1082, 1090, 197 USPQ 601, 607 (CCPA 1978).

In response, applicants argue, as set forth in the amendment filed 11/5/03, that while the discovery of new properties of old compositions does not impart patentability onto the old composition themselves, applicants are not claiming the composition but rather a method of using the composition for preventing a whitening phenomenon. With regards to *In re May*, applicants argue that *May* supports applicants position that new and unobvious methods are

patentable and note that in *May*, the court went on to reverse the examiner's rejections of claims 2-5 and 7-10 which recited a process of using a new compound.

However, firstly, it is noted that MPEP 2112.02 pointed to by the examiner is applicable to process of use claims not only compositions. Secondly, with respect to *In re May*, it is noted that in *May*, claims 1-10 were drawn to method of affecting analgesic and morpholine antagonistic activity without producing physical dependence in animals wherein the method comprises administering to the animal an effective dosage of a certain claimed compound.

The court upheld examiner's rejections of claims 1 and 6, which are method claims, given that the prior art disclosed method of effecting analgesia using specific compound that fell within the genus of compounds claimed. While the prior art did not disclose method of affecting nonaddictive analgesia using the compound, the court held that while appellants have discovered a hitherto unknown property, i.e. nonaddictiveness, of the species disclosed by *May*, such discovery does not constitute a new use.

Thus, it is clear that contrary to applicants' arguments, claims which are drawn to process of using are not patentable when the claims recite using an old composition or structure. That is, in *May*, the courts upheld rejection of claims drawn to process of using wherein the prior art explicitly disclosed the claimed compound even though the prior art did not recognize the claimed use of the compound, i.e. nonaddictiveness. It is the same situation in the present application wherein the present method claims only recite a property or result of using the copolymer, i.e. preventing a whitening phenomenon. Given that as described above in *May*, the discovery that the claimed copolymer has a new property, i.e. preventing a whitening

phenomena, does not constitute a new use, the prior art cited by the examiner remains relevant against the present claims.

While the court did reverse the rejection of claims 2-5 and 7-10 in *May*, this was not because the claims were drawn to a process of using but rather because the claims recited a novel compound. The prior art did not explicitly disclose the claimed compounds of claims 2-5 and 7-10 but the examiner argued that it would have been obvious to one of ordinary skill in the art to use isomers of the compounds disclosed in the prior art and that such isomer would also possess analgesic activities. However, the rejection of the claims was not upheld in light of applicants' affidavit evidence which disclosed evidence of unexpected results.

This is not the situation in the present rejections of record given that all the prior art cited by the examiner does in fact explicitly disclose the claimed copolymer.

Therefore, although the present claims are drawn to process of using the copolymer, given that the claims recite using an old composition or structure, i.e. the copolymer, and the present claims "use" is directed to a result or property of the copolymer, it is the examiner's position that the claims are properly anticipated by the prior art of record.



Callie E. Shosho
Primary Examiner
Art Unit 1714